

Remarks:

Claims 1-20 are pending. Applicant has amended the claims to distinctively claim the subject matter of the invention. By virtue of this amendment, claims 1-5 and 8-20 are amended. No new matter is added as support for the amendments is found within the Specification and the drawings. It is submitted that the application, as amended, is in condition for allowance. Accordingly, reconsideration and reexamination are respectfully requested.

§102 Rejection(s):

Claims 1-20 are rejected under 35 U.S.C. §102(b) as being unpatentable over U.S. Patent No. 6,463,300 to Oshima (hereafter “Oshima”). This rejection is respectfully traversed.

It is respectfully noted that anticipation of a claim under 35 U.S.C. §102 (a), (b) and (e) requires that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," that "[t]he identical invention must be shown in as complete detail as is contained in the ... claim" and "[t]he elements must be arranged as required by the claim." MPEP §2131.

Oshima is directed to preventing unauthorized use of a mobile device in a mobile communication network when the device's SIM card is replaced. See column 3, lines 1-18. Oshima discloses a mobile device with a memory 25 for storing configuration data from a SIM card. The memory 25 also stores a secret number for authorizing a new SIM card. See column 6, lines 28-34. Upon detecting a new SIM card, the mobile device requests the secret number from the user. The mobile device is allowed to access the mobile communication network only if the user correctly inputs the secret number. See column 6, lines 43-54.

Oshima fails to disclose at least one of the elements recited in claim 1, as amended. In particular, Oshima fails to disclose “searching entries in a data structure external to the first identity module for first configuration data associated with the first identity module, in response to determining the first identity module is different from the second identity module; and automatically configuring the mobile device to operate in the mobile communications network, without input from a user or a service representative, by replacing the second configuration data

with the first configuration data, in response to finding the first configuration data in the data structure.”

Even if Oshima discloses retrieving configuration data (e.g., IMSI, PIN, and telephone number) from an inserted SIM card (i.e., first identity module) (see column 6, lines 35-38), claim 1 recites searching entries in a data structure external to the first identity module for first configuration data associated with the first identity module. In other words, retrieving configuration data stored within a SIM card, as disclosed in Oshima, is not equivalent to retrieving configuration data stored external to the SIM card, as recited in claim 1.

In addition, even if Oshima discloses retrieving configuration data from an inserted SIM card in order to determine whether the SIM card is the same as a previously inserted SIM card (see column 6, lines 38-42), claim 1 recites searching for first configuration data, in response to determining the first identity module is different from the second identity module. In other words, retrieving configuration data during determining that a currently inserted SIM card is different from a previously inserted SIM card, as disclosed in Oshima, is not equivalent to retrieving configuration data after determining that the currently coupled first identity module is different from the second identity module, as recited in claim 1.

Further, Oshima does not disclose automatically configuring the mobile device to operate in the mobile communications network, without input from a user or a service representative, as recited in claim 1. In fact, Oshima directly teaches away from the above element of claim 1 by requiring that a user input a secret number correctly before the mobile device is allowed to access the mobile communications network.

Accordingly, since Oshima fails to disclose at least one of the recited elements in the amended claims, the §102 rejection should be withdrawn. Also, since Oshima teaches away from at least one of the elements recited in claim 1, Oshima should be withdrawn for being an improper reference.

For the above reasons, it is submitted that claim 1, as amended, is in condition for allowance. Claims 2-10 depend on claim 1 and should also be in condition for allowance by virtue of their dependence on an allowable base claim. Claim 11, as amended, substantially incorporates the elements of claim 1; therefore, claim 11 and claims 12-20 depending from claim 11 should also be in condition for allowance.

§103 Rejection(s):

Claims 4 and 8-10 are rejected under 35 U.S.C. §103(a) as being unpatentable over Oshima in view of U.S. Patent Publication No. 2004/01953213 to Lee (hereafter “Lee”). This rejection is respectfully traversed.

MPEP §2143 provides:

“To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.”

Since Oshima teaches away from the elements recited in claim 1, a person of ordinary skill in the art could not be motivated to combine Oshima with Lee or any other reference as the resulting combination would also teach away from the elements recited in claim 1. Even if Lee could be combined with Oshima, however, Lee fails to cure the deficiencies of Oshima.

Lee is directed to a method for registering network information in a mobile terminal using a smart card. The method comprises receiving system network set-up information from a wireless communication system; connecting a smart card to the mobile terminal and determining if there is network set-up information in the smart card; storing the newly-acquired network set-up information in a file stored in the smart card if there is no network set-up information present in the smart card; comparing the existing network set-up information in the smart card with the

newly-acquired system network set-up information; and updating existing network set-up information with the newly-acquired system network set-up information. See Abstract.

Lee fails to teach or suggest all the elements recited in claim 1, as amended. In particular, Lee fails to teach or suggest “determining whether a first identity module coupled to the mobile device is different from a second identity module previously coupled to the mobile device; searching entries in a data structure external to the first identity module for first configuration data associated with the first identity module, in response to determining the first identity module is different from the second identity module; and automatically configuring the mobile device to operate in the mobile communications network, without input from a user or a service representative, by replacing the second configuration data with the first configuration data, in response to finding the first configuration data in the data structure.”

As such, Lee fails to cure the deficiencies of Oshima as Lee also fails to teach or suggest “searching entries in a data structure external to the first identity module for first configuration data associated with the first identity module, in response to determining the first identity module is different from the second identity module; and automatically configuring the mobile device to operate in the mobile communications network, without input from a user or a service representative, by replacing the second configuration data with the first configuration data, in response to finding the first configuration data in the data structure,” as recited in claim 1

While the suggestion to modify or combine references may come from the knowledge and common sense of a person of ordinary skill in the art, the fact that such knowledge may have been within the province of the ordinary artisan does not in and of itself make it so, absent clear and convincing evidence of such knowledge. *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998).

Here, the modification or combination proposed by the Examiner is not based on any clear and convincing evidence of a reason, suggestion, or motivation in the prior art that would have led one of ordinary skill in the art to combine the references. Rather, the reason, suggestion

and motivation for the combination of references proposed by the Examiner simply is impermissible hindsight reconstruction given the benefit of Applicant's disclosure.

The Federal Circuit has consistently held that hindsight reconstruction does not constitute a *prima facie* case of obviousness under 35 U.S.C. §103. *In re Geiger*, 2 USPQ 2d 1276 (Fed Cir. 1987). Unfortunately, the Examiner rather than pointing to what the prior art discloses and teaches as to making the suggested modification relies on assumptions and statements without any support in the record. As such, the Examiner's statements regarding obviousness and motivation to modify are but shortcuts to a conclusion of obviousness devoid of the required analytical approach based on what is actually disclosed in the prior art.

Reliance on impermissible hindsight to avoid express limitations in the claims and setting forth unsupported hypothetical teachings to recreate the Applicant's claimed invention cannot establish a *prima facie* case of obviousness. Since obviousness may not be established by hindsight reconstruction, Applicant invites the Examiner to point out the alleged motivation to combine with specificity,¹ or alternatively provide a reference or affidavit in support thereof, pursuant to MPEP §2144.03.²

Since no reasonable justification is provided in the Office Action as to how such modification or combination is possible and obviousness may not be established based on hindsight and conjecture, it is respectfully requested that the §103 rejection be withdrawn.

For the above reasons, it is submitted that claim 1, as amended, is in condition for allowance. Claims 2-10 depend on claim 1 and should also be in condition for allowance by virtue of their dependence on an allowable base claim. Claim 11, as amended, substantially

¹ *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

² "The rationale supporting an obviousness rejection may be based on common knowledge in the art or "well-known" prior art . . . If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position. When a rejection is based on facts within the personal knowledge of the examiner . . . the facts must be supported, when called for by the applicant, by an affidavit from the examiner."

incorporates the elements of claim 1; therefore, claim 11 and claims 12-20 depending from claim 11 should also be in condition for allowance.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has expressly argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number (888) 789 2266 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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